

PATENT
ROSE 3.0-036

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of
Hiatt et al.

Serial No. 08/300,484

Filed: September 2, 1994

For: ENZYME CATALYZED TEMPLATE-INDEPENDENT
CREATION OF PHOSPHODIESTER BONDS USING
PROTECTED NUCLEOTIDES



Group Art Unit: 1623

Examiner: James O. Wilson

Date: March 1, 1999

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GROUP 180

Assistant Commissioner For Patents
Washington, D.C. 20231

RESPONSE

Sir:

This is in response to the Official Action mailed August 31, 1998. A Petition for an extension of three months in which to respond, and which authorizes the Commissioner to charge Deposit Account No. 12-1095 for the requisite fee and any other fees that may be due and owing, is attached hereto and incorporated herein by reference.

REMARKS

Claims 1-31 have been rejected under § 103(a) as unpatentable over each of *Hyman* (U.S. Patent No. 5,436,143) and WO 90/01064 ("the '064 application"). The Examiner alleges that *Hyman* discloses a process for oligonucleotides synthesis which utilizes removable blocking groups for the 5'-nucleoside triphosphate (citing Fig. 1 of *Hyman*), thus rendering the claimed methods and compositions prima facie obvious. The Examiner also alleges that the '064 application discloses a method of synthesizing polynucleotides wherein the 5'-end of an oligonucleotides is treated with TdT and a

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231 on March 1, 1999

(Date of Deposit)

Signature: _____

THOMAS M. PALISI

(Typed or Printed Name of Person Signing Certificate)